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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,241	04/04/2001	David W. Sanborn		2036

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,241

Applicant(s)

SANBORN ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

Applicant's specification lists related prior art. However, the listing is not taken to be a formal Information Disclosure Statement. If applicant desires to submit such an IDS, it should be a separate listing with an area for the examiner to initial each listed reference and include a place to sign and date the IDS upon consideration.

Claim for Priority

Applicant mentions priority to provisional application 60/193942. It appears that the non-provisional application (09/825241) was filed more than a year after the provisional. Therefore it appears that applicant cannot claim priority beyond the filing date of the non-provisional, or 4/4/2001.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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- It is unclear how one of ordinary skill would accomplish the delivery of the advertising and user's message by way of a telephone message. The specification does not adequately support or enable such a feature.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1, 6-8, 12, 13, 16 are of unclear claim scope. The use of the "may" language makes it unclear whether these method steps are positively required to be performed.
- Claims 4, 5, 10, 14, 16 are of unclear claim scope. The use of the "such as" language makes it unclear whether these features are positively required. Claim 16's "or similar" language also makes the exact claim scope uncertain.
- Claim 1 line 22, there is no antecedent basis for "the card."
- Claim 4, there is no antecedent basis for "the mechanism."
- Claims 4, 5, 10, 14, 16 are of unclear claim scope. The use of the "such as" language makes it unclear whether these features are positively required.
- Claim 14 line 23, there is no antecedent basis for the "producer system."
- Claim 14 page 8 line 1, there is no antecedent basis for the "sender" or "receiver."

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- Claim 14 page 8 line 10, there is no antecedent basis for the user messages.
- Claim 14 page 8 lines 10-12, there is no antecedent basis for the advertising.
- Claim 15, it is unclear how a method claim can “permit” anything. A system/structure (such as a programmed computer) can permit this function, but these method claims are merely carrying out the steps of the function.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1, 2, 4-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Lockhart et al (US6732152). As stated above, applicant's earliest date is the filing date of 4/4/2001. Lockhart et al provides a filing date (as well as earlier provisional dates) which qualifies as an “e” reference. Much of the language in the claims includes the optional “may” language which essentially renders the stated features as non-limiting.

Regarding claims 1, 5, Lockhart et al teaches an online system where a user selects from a gallery of stored images, enters a personalized text message and enters a delivery address. The system then prints the content and forwards it to a surface mailing facility for physical delivery to the recipient [abstract, cols 3-4]. The collection of stored images are taken to provide a gallery which the user may browse; browsing for a

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particular image (football for example) is taken to meet the “user may search” language. Any stored image can be taken to meet the broad “advertising image” in that the images are advertising their content, whatever that may be. Lockhart et al teaches that the user may also upload a personal file. The user logs in and/or registers and identifies themselves to the system [col 10 lines 19-22]. Regarding the “may indicate a coupon” language, this is taken as an optional feature not required by the prior art at this time. However, Lockhart et al teaches that the sender could be a business and that ads or coupons could be included that are related to their business – such is taken as indicating a coupon. Regarding the printing on the front vs. the back, Lockhart et al shows in figure 7 that the image is printed on one side and the message and address on the other side. Further, Lockhart et al teaches that ads or coupons could be provided on peelable covers that conceal part or the entirety of one side [col 15 lines 36-63, fig 7]. Because one could not operably cover the entire side having the address, it is taken to teach at least the advertisement/coupon peel to be located on side 702 with the message and address on the other side.

Regarding claims 2, 4, Lockhart et al teaches the terminal to be connected to the server via the Internet [col 5 lines 45-50]. Lockhart et al teaches that the terminal can be a kiosk [col 5 line 2].

Regarding claim 6, the method step of the user “may” identify themselves at any time is not taken to provide a limiting step.

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Regarding claim 7, Lockhart et al teaches the login process prior to completion. The presentment of the sender's information as the return address identifies them with name and mailing address.

Regarding claims 8-11, Lockhart et al teaches individuals as well as businesses sending messages with the system. Any person who operates the system to send a message or who receives a mailed message is taken as an "individual", whether they are affiliated with or acting in the capacity of a business or not. Any message from a business is taken as a "notification from a business." The ads and coupons of Lockhart et al are inherently associated with a good or service.

Regarding claim 12, the language is not taken to be limiting. Nonetheless, the coupon is taken to inherently provide an image.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. Official Notice is taken that it is well known to offer a free, but ad-supported service or a user-paid service. It would have been obvious to one of ordinary skill in the art to enable the user to choose advertising to be included with the service in order to lower or eliminate the cost of the service. AS stated above,

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Lockhart et al is taken to meet the front vs. back printing claims, yet it would have been obvious to have arranged the content in any way on either side of the mailed card/item as a choice of design.

Regarding claim 3, it would have been obvious to one of ordinary skill in the art that a home or office PC user can be on a private LAN with a gateway to the Internet-based server service.

Regarding claim 6, the user logs in after the images and messages are selected, but before addressing is completed. It would have been obvious to one of ordinary skill in the art to have allowed login at any time prior to finalizing the product for delivery. In the case of user-paid delivery, the user would be required to log in at least before the delivery of the product is finalized.

7. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al in view of Small (US5513117). Browsing for a particular image (football for example) is taken to meet the "permit the user to search for specific images" language. Lockhart et al teaches showing an electronic analogue of the medium [fig 7]. Lockhart et al teaches user images, system gallery images as well as system logos (1108 – fig 8) which can be provided to the card. Further, the bar-coding can also taken to provide combined images. Lockhart et al teaches tracking transaction requests and production results in order to provide quality control [col 15 lines 8-20]. The printing of the message, image, sender and recipient information is taken to provide recording the sender/recipient identification and components to be printed. Lockhart et al teaches

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notifying users of the results (sending) of the transactions [col 15 lines 24-28]. Lockhart et al teaches that 3rd party advertising images can be used to defray the costs of delivery [col 15 lines 64+]. This is taken to include tracking/allocating production and mailing expenses among advertisers and users. Lockhart et al appears to only teach delivery of the content via surface mail. Small also teaches electronic greeting cards that are designed online and can be delivered electronically or via surface mail. It would have been obvious to one of ordinary skill in the art to have enabled delivery of the creation electronically as well in order to provide more efficient and less expensive communications.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc